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EXAMINER
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REICHLE, KARIN M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 12/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/082,211

Applicant(s)

ONISHI ET AL.

Examiner

Karin M. Reichle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Specification***

1. The substitute specification filed 11-9-04 has still not been entered as such includes new matter. The substitute specification, e.g. page 8, lines 1-5 of the marked up copy, sets forth an elastic member which extends midway between the end portions. While, e.g., page 7, lines 17 et seq of the original specification disclosed that the elastic member extended along a zone of the distal end portion rather adjacent its proximal end portion, i.e. if one considers the terminal proximal edge as 0% and the terminal distal edge as 100%, then more than 50% but less than 75%, where is it originally disclosed that the member is part of the proximal end portion, i.e. 50% or midway? If Applicant traverses the rejection the portion of the specification which clearly supports such language should be set forth. Also, for another example, on page 24, line 12 of the marked up specification, i.e. where is a "free end region" otherwise described? Where is the free end region and the distal end portion of the latter batt structure disclosed as being one and the same. As best seen in Figure 2 the free end region includes portions of both end portions. See response to arguments section *infra* also.

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

For example:

### *Drawings*

3. The drawings were received on 4-18-05. These drawings are not approved. Since the drawings reflect changes set forth in the substitute specification and the latter has not been entered, the drawings are not approved.

4. The drawings are objected to because the cross-sectional lines, e.g., in Figure 1, line A-A, should be denoted by Roman or Arabic numerals. Note any changes made to such lines should also be made to any textual description of such lines, e.g., page 4, line 1-page 5, line 2 of the description. In Figure 1, the rightmost 5 does not denote the sheet which wraps core 6. The description and the Figures are inconsistent with regard to what the surfaces of the batt structures 4A and 6A are, which structures include the cores 4 and 6, respectively, as well as other sheets, and what the surfaces of the cores 4 and 6 are. For example, on page 6, lines 7-9, a body facing surface of structure 4A is described as 4c yet in Figure 1, the surface denoted 4c is the surface of the core 4 not the batt structure 4A. This also applies to what the structure 9 is, i.e. does it underlie the cuffs 7 or not, see, e.g. page 9, lines 3-4 and compare to Figure 1. The drawings and description should be carefully reviewed and amended, as necessary, to make the specification consistent throughout. Figure 1 does not show the elastic 10 between sheets 2 and 5 at the right side thereof nor along the distal end portion as set forth on page 7, lines 17 et seq. The latter objection also applies to Figures 2 and 4. As shown the elastic is not clearly along the distal end portion rather adjacent the proximal edge portion. This objection also applies to elastic 19 in Figures 5 and 6 and elastic 10 in Figure 10. In Figure 2, 13 should be 14. In Figure 2, 6a should be deleted. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing

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sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Description***

5. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: the new abstract, lines 5 and 9, page 2, lines 9-11 and page 21, first paragraph of the originally filed specification.

6. The disclosure is objected to because of the following informalities: The description and the Figures are inconsistent with each other and themselves with regard to what the surfaces of the batt structures 4A and 6A are, which structures include the cores 4 and 6, respectively, as

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well as other sheets, and what the surfaces of the cores 4 and 6 are. For example on page 6, lines 7-9, a body facing surface of structure 4A is described as 4c yet in Figure 1, the surface denoted 4c is the surface of the core 4 not the batt structure 4A. See also page 6, lines 13-14 and the sentence bridging pages 10-11, i.e. what are the flaps 8 and what are the ends 4a of the batt structure 4A? This also applies to what the structure 9 is, i.e. does it underlie the cuffs 7 or not, see, e.g. page 9, lines 3-4 and compare to Figure 1. See also, e.g., page 9, first full paragraph and compare to the last paragraph on page 11. Note also the first two paragraphs on page 12. The drawings and description should be carefully reviewed and amended, as necessary, to make the specification consistent throughout. Page 12, first sentence is unclear, i.e. should the last "7a" be "7a"? On page 13, line 2, "4" should be --4A--. On page 15, line 7, "18 a2- The batt structure 18" should be --18a2. The batt structure 18A--. On page 15, line 12, "region" should be --regions--.

Appropriate correction is required.

### ***Claim Objections***

7. Claims 1-12 are objected to because of the following informalities: Claim 1, line 9 still appears to be missing words or are grammatically incorrect. This objection also applies to similar language in claim 11. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

8. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not

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described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 now requires an elastic member which extends aside the distal end portion and toward the proximal end portion. It is noted that “aside” as defined by the dictionary is “on or to one side” and “toward” is defined as “in the direction of”. While, e.g., page 7, lines 17 et seq of the original specification disclosed that the elastic member extended along a zone of the distal end portion rather adjacent its proximal end portion, i.e. if one considers the terminal proximal edge as 0% and the terminal distal edge as 100%, then more than 50% but less than 75%, where is it originally disclosed that the member is toward the proximal end portion, i.e. less than 100% but more than 50%? If Applicant traverses the rejection, the portion of the specification which clearly supports such language should be set forth.

### ***Claim Language Interpretation***

9. Since Applicant has not specifically defined any of the claim terminology, such terminology will be given its usual, i.e. dictionary, meaning. Therefore, “substantially connected” is defined as substantially directly or indirectly connected. See also discussion in the preceding paragraph with respect to “aside” and “toward”. Also see MPEP 2163.06, I. with respect treatment of subject matter considered new matter and rejections based on prior art, i.e. will be considered.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-4 and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paragon Trade PCT '921 in view of Dreier '660 and Ronnberg '544.

Paragon Trade discloses a diaper 10, as shown in Figure 1, comprising a basic absorbent batt structure 34 and a supplementary absorbent batt structure 702. The basic absorbent batt structure 34 has a liquid pervious body faceable surface sheet 30, a liquid impervious garment faceable surface sheet 32, a front waist region 22, a rear waist region 24 and a crotch region 26. The supplementary absorbent batt structure 702 has a liquid pervious body faceable surface 704 or the upper surface of 702 and an opposite surface 706 or the lower surface of 702 as shown in Figure 2. The supplementary absorbent batt structure 702 also has a proximal end portion 724 and a distal end portion 728, as shown in Figure 1, with the proximal end portion 724 lying in the front portion 22. Contraction of elastic members 718 encourages the side edges of the supplementary absorbent batt structure to be pulled nearer to the centerline, i.e. laterally, so the distal end portion curves so as to delineate a circular arch which is convex upward with respect to the body faceable surface of the base batt and consequently a pocket opening 802 from the front waist region to the crotch region is formed between the batt structures, see, e.g. Figures 2-4, last paragraph of page 3, first paragraph of page 5 and the paragraph bridging pages 15-16. Therefore the '921 reference includes all the claimed structure except for an elastic member as



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set forth in the next to last section of claim 1. See Dreier, e.g. at Figures 10 and 16, which teaches a supplementary absorbent structure which has a transverse elastic member in combination with members in containment flaps for improved shaping of the distal end portion relative to the basic batt to form a pocket, see, e.g., col. 18, lines 9-11 and the Background of the Invention section. The transverse elastic member is “aside the distal end portion and toward the proximal end portion”, see Claim Language Interpretation section *supra*. See also Figures 4 and 5 and col. 5, lines 36-46 of Ronnberg ‘544 which teach elastic members, i.e. members 36 not 34, which are transversely oriented cause the upper batt structure to be pulled laterally so as to curve upward relative to the bottom batt. Such elastic members are “aside the distal end portion and toward the proximal end portion”, see Claim language Interpretation section *supra*. Therefore to employ a transverse elastic in combination with elastic members of the flaps of Paragon as taught by Drier and Ronnberg would be obvious to one of ordinary skill in the art in view of the recognition that such combination would improve shaping of the distal end portion to form a pocket. In so doing the diaper of the prior art combination inevitably and necessarily function as set forth in the last section of claim 1. It is noted that claims 1-4 and 8 do not require the elastics be located between the batt structures or be directly connected to each batt structure at the end regions.

With respect to claim 2, the basic batt structure comprises a liquid pervious topsheet 30, a liquid impervious backsheet 32 and a liquid absorbent first core 34 as shown in Figure 2.

With regard to claim 3, the supplementary absorbent batt assembly includes a liquid absorbent second core 702 and a liquid pervious sheet 704 as shown in Figure 2.

With regard to claim 4, see discussion of claim 1 supra and the last paragraph on page 5 and page 22, first and second full paragraphs.

With regard to claim 8, the supplementary batt 702 comprises a higher percentage of superabsorbent material than the basic batt 34 as disclosed at page 14, first full paragraph, page 16, last paragraph, page 17, second paragraph, i.e. the core of each batt can be the same material with the upper core having superabsorbent but the lower core not.

With respect to claims 9-11, it is noted that the claims do not require the elastic member be positioned between the uppermost layer of the basic structure and the lowermost layer of the upper structure just between a liquid permeable body faceable surface of the basic batt structure and a lower surface of a supplementary absorbent batt structure, i.e. the lower surface can be the lower surface of the absorbent core of the supplementary absorbent structure. Therefore see Ronnberg at col. 5, lines 35-45, i.e. the elastics can be on the lower surface of the top core but above the body faceable surface of the lower core. Also see Dreier at Figures 13 and 15.

12. Claims 5-7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paragon Dreier and Ronnberg as applied to claim 1 above, and further in view of Onishi '565.

Paragon discloses all aspects of the claimed invention with the exception of a second supplementary batt assembly identical to the first supplementary batt assembly but lying in the rear waist region and having a smaller dimension such that the basic batt is exposed between the distal end portions of the supplementary structures. Onishi discloses a diaper having a first pocket formed by a supplementary batt structure located in the front waist region as shown in Figure 1. Onishi further discloses a second supplementary batt structure located in the rear waist region which is identical to the first supplementary batt structure except that it is smaller, i.e.

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longitudinally shorter, i.e. smaller dimension, so that the underlying batt structure is exposed therebetween and to form a second pocket between the crotch region and the rear waist region as shown in Figure 2. The second pocket structure provides a way to further trap waste and minimize contact of waste with the wearer of the diaper as described in paragraph 16 of the translation. Paragraph 16 also discloses the use of both pockets is interchangeable with the use of just a front pocket, i.e. both supplementary batt structures are interchangeable with just a front supplementary batt structure. Therefore it is the Examiner's first position that to make the one front pocket structure of Paragon a two pocket structure, i.e. front and rear supplementary batt structures, instead would be obvious in view of the interchangeability as taught by Onishi. Alternatively, the Examiner's second position, to employ a second supplementary batt structure in the rear waist region to form a second pocket as taught by Onishi on the Paragon diaper would be obvious to one of ordinary skill in the art at the time of invention in view of the recognition that such would further trap solid and liquid waste independently and minimize contact of waste with the wearer and the desire of such by Paragon.

### ***Double Patenting***

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/054,825(2002/0099351) in view of Dreier and Ronnberg. Since the instant application was filed after '825, the one way In re Vogel test applies, i.e. are the instant claims obvious in view of the '825 claims? The answer is yes. The '825 claims include all the claimed structure except that 1) they don't claim transverse elastic member(s), and 2) they do claim other structures, i.e. gasketing cuffs. With regard to 1) see the last section of claim 1 of '825, and claim 1, last two sections and similar language in claims 5 and 11-12 of the instant application and the rejection in paragraph 11 supra. With regard to 2), once the applicant has received a patent for a species, he/she is not entitled to a patent for the generic or broader invention. This is because the more specific anticipates the broader. The '825 claims anticipate the instant claims. Note the rationale in In re Goodman cited supra.

This is a provisional obviousness-type double patenting rejection.

### ***Response to Arguments***

15. Applicant's remarks on pages 8-9 filed 4-18-05 with regard to the informalities have been noted but are either deemed moot in that they have not been repeated or are deemed not persuasive for the reasons set forth supra. Specifically, contrary to Applicants remarks, as originally disclosed the supplementary batt structure is 6A and has a body facing surface(undenoted) above a upper surface 6c of the second core 6 and an opposed lower surface

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beneath a lower surface of the second core, a proximal end portion 6a1 joined to the basic batt by sheet 5 and a distal end 6a2. Therefore, whether the proximal end begins at 5a or adjacent the proximal end of core 6, Figures 2 and 6 do not show the elastic member midway between the end portions, also see, e.g., Figures 4 and 8, as previously claimed and as set forth in the not entered substitute specification but also do not show the elastic member toward the proximal end portion, i.e. in addition to more than 50% but less than 75% as originally described now includes 75% to less than 100%, see discussion in paragraph 8 supra. Applicants remarks on pages 10-14 traversing the prior art rejections have been considered but are deemed nonpersuasive because Applicant's arguments are narrower than the scope of the claim language, e.g. claims 11-12 do not require the elastic member be "aside the distal end portion and toward the proximal end portion" at all and the remainder of the claims include the elastic member "aside the distal end portion and toward the proximal end portion" as interpreted, and narrower than the prior art rejection and the prior art references, e.g. the portion of Ronnberg cited refers to elastic 36 not 34.

### *Conclusion*

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on (571) 272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Karin M. Reichle  
Primary Examiner  
Art Unit 3761

KMR  
June 15, 2005